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THE TTAB

Paper No. 19
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fortis Benefits Insurance Company

Serial No. 75/242,114

Marsha Stolt of Fish & Richardson P.C., P.A. for Fortis
Benefits Insurance Company.

Amos T. Matthews, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Cissel, Hairston and Hanak, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 14, 1997, applicant filed the above-
referenced application to register the mark "DCP" on the
Principal Register for "insurance services, namely, claims
administration and processing," in Class 36. The
application was based on applicant's assertion that it
possessed a bona fide intention to use the mark in commerce
in connection with the services.

After the application was approved for publication, applicant filed a Statement of Use claiming that applicant had used the mark in interstate commerce since June 20, 1997 by applying it to advertising and promotional materials for applicant's services. Specimens of use were attached.

The Examining Attorney found the specimens to be unacceptable as evidence of use of the mark in connection with the services recited in the application. Applicant responded by submitting additional specimens, but the Examining Attorney did not accept them either.

Applicant then filed a Notice of Appeal, amended the recitation of services to state the services with which the mark is used as "insurance services, namely, claims administration and processing provided by employees who have completed specialized training and the subject," in Class 36, and requested reconsideration of the requirement for substitute specimens.

The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for reconsideration of the requirement for substitute specimens. Upon reconsideration, he maintained that the specimens applicant has submitted are not

acceptable, and returned the application file to the Board for resumption of action on the appeal.

Both applicant and the Examining Attorney filed appeal briefs, but applicant did not request an oral hearing before the Board.

The sole issue in this appeal is the acceptability of the specimens of use submitted by applicant. Based on careful consideration of the record in this application and the arguments presented by both applicant and the Examining Attorney, we find that the requirement for acceptable specimens is well taken.

Section 1(a)(1) of the Lanham Act provides that an application for registration must include specimens evidencing the use of the mark sought to be registered. Implicit in this section is that the specimens must show the mark used to identify the services specified in the application. In re Adair, 45 USPQ2d 1211 (TTAB 1997).

The Examining Attorney does not contend that applicant is not rendering the services recited in the application, and he readily concedes that the letters sought to be registered appear in several different places in the printed advertisements submitted by applicant as specimens of use. The problem the Examining Attorney has with the specimens is that they show use of "DCP" as a designation

used to signify the educational achievements or qualifications of the individual employees who work for applicant, rather than as a service mark used to identify the source of the services applicant provides.

The specimens originally submitted with the application are advertisements which show the letters sought to be registered in two places. The text of the advertisement begins with the following statement:

"To insure competency in all aspects of disability claims management, Fortis Benefits Insurance Company has implemented a new skills certification program with an emphasis on continuing education for disability claims employees."

The program is further described as consisting of tests on a range of subjects that all disability claims employees of applicant are required to complete. The advertisement goes on to state that

"[u]pon completion, employees earn a diploma (sic) and the right to use the Disability Claims Professional (DCP¹) designation, exclusive to Fortis Benefits, after their names. 'The DCP designation sets us apart in the industry as an organization that values and promotes knowledge, continuous learning and development, and the professionalism of its claims staff,' says Tom. 'It was introduced to recognize

¹The specimens show the service mark designation indicated by the letters "SM" in superscript each time the letters "DCP" appear, but the equipment on which this opinion is produced is incapable of printing this symbol.

disability claims employees for their accomplishments in continuing education."

A box inserted in the middle of the page on which this text appears lists highlights of the program, including the notation "DCP designation introduced to recognize continuing education efforts."

The second specimen submitted by applicant is another printed advertisement for applicant's services. The following is the only part of the advertisement which uses the letters sought to be registered. It appears under the heading of "Who processes the claims?":

"All members of the disability claims area are required to earn the Disability Claims Professional (DCP) designation, exclusive to Fortis Benefits. Earning this designation involves taking eleven exams designed to test product and procedure knowledge and claims management thinking. To maintain the designation, disability claim employees must successfully complete an annual exam on topics not included in their original testing. They must also pass a recertification test consisting of previous exam material every other year."

We agree with the Examining Attorney that as used by applicant in the specimens, the letters "DCP" indicate that applicant's employees have met applicant's requirement that they pass tests which measure their knowledge in the field of processing claims, but neither of the specimens submitted by applicant shows the letters applicant seeks to

register used as a service mark to identify the source of the insurance services recited in the application.

The Board has held that a term used solely as a designation for those who have completed an applicant's educational course does not function as a mark to identify and distinguish the applicant's educational services from similar services provided by others. In re Thacker, 228 USPQ 961 (TTAB 1986). In that case, we drew the analogy to a number of previous decisions involving the issue of whether titles or degrees were being used as certification marks or as collective membership marks, rather than as service marks. We concluded that unless the specimens of record in an application clearly show the matter sought to be registered used "in a manner which would be perceived as identifying the services of applicant rather than the individuals who complete applicant's educational course," registration is not warranted.

In the case at hand, the specimens, as noted above, do not show the letters "DCP" used to identify the source of the insurance services set forth in the application. Instead, what the specimens show is that individual employees of applicant are authorized to use the letters after their names as a "designation" that they have met applicant's standards for "knowledge, continuous learning

and development, and professionalism..." Use in this manner, as a designation of the qualifications of the individuals, is not use of the letters to indicate the source of the services performed for applicant by such individuals, so the facts that all authorized users of the designation are employees of applicant and that all employees handling disability claims for applicant are required to obtain and maintain their status as Disability Claims Professionals, or "DCPs," is irrelevant.

The instant case is not analogous to *In re Advertising & Marketing Development*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987). There, the issue was whether the mark was being used as a service mark for both for the service of promoting the sale of the goods and services of the applicant's clients as well as for the services provided by the clients themselves. The applicant was an advertising agency which sold promotional campaigns in which the term sought to be registered was used by applicant's clients to promote the services of the clients, but the record also included specimens in which the mark clearly was used by the applicant to identify the promotional services applicant provided to its clients.

In the case at hand, however, we are not presented with a single instance in which the letters sought to be

registered are used in any way other than in reference to the fact that individuals employed by applicant have met applicant's training requirements.

Applicant's basic argument is that "[a]pplicant believes that the Examining Attorney has inappropriately focused his attention on the few sentences surrounding the mark as it is used in the Specimen Brochure, rather than viewing the mark as it is used within the context of the Specimen Brochure as a whole." (brief p. 3). While both the Board and the Examining Attorney have considered both specimens in their entirety in order to evaluate the registrability of the designation in issue, it is completely appropriate to focus our attention on precisely how the letters are used in the specimen advertisements because it is this use which must provide the basis upon which we determine whether or not the letters are used as a mark to identify applicant's services and distinguish them from similar services rendered by others.

Because the specimens submitted by applicant do not show the letters sought to be registered used as a service mark to identify the source of the services recited the application, the requirement for acceptable specimens under Section 1(a)(1) of the Lanham Act is well taken.

Decision: The refusal to register is affirmed.

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